

Provisional Election and Request for Withdrawal and Reconsideration

With regard to the restriction requirement as to inventions:

Applicant provisionally elects that claims 1 - 13 be examined, recited by the Examiner as Invention I.

Applicant, in the response to the earlier restriction requirement, has cancelled the method claims 14-15 and 22-23. Therefore, there are only two groups left: Invention I and Invention III.

Pursuant to the telephone conference with the Examiner on Monday, November 23, 2009, the Examiner agreed to withdraw the second restriction requirement brought with regard to Invention III, claims 16-21.

Applicant respectfully requests that this restriction requirement be withdrawn on the record and that examination of claims 1-13 and 16-21 proceed.

With regard to the restriction requirement as to species:

Applicant provisionally selects the species III, which, according to the Examiner, is drawn to Figure 2(c) and claims 2-5.

Applicant makes this election of species with traverse and requests reconsideration.

MPEP 805.05(c) states that “To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e. there would be a serious search burden...” In other words, both conditions have to be met for a restriction on species to be proper.

MPEP 809.02(a) Election of Species cites 808.01(a) as authority for when restriction between species is appropriate. MPEP 808.01 states that “the particular reasons relied upon by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated.” In this case, the examiner has not shown how the species have two-way distinctness and how there would be a serious search burden. In this case, the examiner merely stated that “The species are independent or distinct because the claims to the different species recite the mutually exclusive characteristics of such species.” This statement makes no reference to the specific characteristics recited by the claims. MPEP 808.01 states that “A mere statement of conclusion is inadequate.”

In addition, the burden of effort to search the art has not been demonstrated to be “serious.” All the examiner stated was that “[t]here is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search...” Yet the examiner overlooks the fact that all the claims are directed to an “electrostatic spraying device.” Indeed, this application is a national stage application from PCT/GB04/01431, so a search of the original 23 claims

has already been conducted and is available from the EPO. Further, the examiner is undertaking a search of the generic claims. No sub-classification for searching has been presented that places one species in a different category from the other. There is simply no “serious burden” in searching all the species.

Therefore, Applicant respectfully requests that the Examiner withdraw the restriction of species.